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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,851	06/18/2001	Bogdan C. Maglich	HIENER.1CPC1CP	9955

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EXAMINER
KEITH, JACK W

ART UNIT	PAPER NUMBER
3641	

DATE MAILED: 05/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/883,851	Maglich
Examiner	**Art Unit**
Jack Keith	3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Apr 15, 2003*.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-17* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7 and 9-18 of copending Application No. 09/788,736. Although the conflicting claims are not identical, they are not patentably distinct from each other because as each independent claim sets forth a particle generator, first and second subatomic particles, photon and alpha detectors and analyzers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Specification

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to provide an adequate written description of the invention and as failing to adequately teach how to make and/or use the invention, i.e. failing to provide an enabling disclosure.

As presently set forth in figure 8, the gamma spectrum analog-to-digital conversion and filtration process system are essentially a black box with no description of the internals thereof.

The disclosure is thus insufficient in failing to set forth in an adequate and sufficient fashion, a description of the internals of the gamma spectrum analog-to-digital conversion and filtration process system which would enable the device to perform all of the features (i.e., inputs, discrimination, conditioning, etc.) that are disclosed and claimed. If applicant is of the opinion that there is a description in the prior art (in the form of literature, etc. having a date prior to the filing date of this application), of the internals of the gamma spectrum analog-to-digital conversion and filtration process system that can accomplish the disclosed and claimed features (i.e., inputs, conditioning, etc.), copies of said literature, etc., must be for appropriate review by the Office. See In re Ghiron et al, 169 USPQ 723, 727.

It is thus considered that the examiner (for the reasons set forth above) has set forth a reasonable and sufficient basis for challenging the adequacy of the disclosure. The statute requires the applicant itself to inform, not to direct others to find out for themselves; In re Gardner et al, 166 U.S.P.Q. 138, In re Scarbrough, 182 U.S.P.Q. 298. Note that the disclosure must enable a person skilled in the art to practice the invention without having to design structure not shown to be readily available in the art; In re Hirsch, 131 U.S.P.Q. 198.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The reasons that the inventions as disclosed are not enabling are the same as the reasons set forth in section 5 above as to why the specification is objected to and the reasons set forth in section 5 above are accordingly incorporated herein.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 5-12 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawa et al (5,076,993).

Sawa sets forth a prior art system capable of meeting applicant's claimed inventive concept (see columns 1-2, lines 5-69). The prior art system discloses a known fast neutron activation (FNA) system/technique for the detection of explosives. The system involves the detection of alpha particles (second atomic particle) generated in a tritium (hydrogen isotope) target which produces 14 MeV neutrons (first atomic particle). The alpha particles and neutrons being emitted in opposite directions. A detector located near the tritium target detects the alpha

particles. The corresponding neutrons are emitted at 180° within a solid angle equal to the solid angle subtended by the alpha detector from the tritium target. This solid angle defines a beam of neutrons that is used to interrogate a sample (e.g., suitcase). A gamma ray (photon) detector is placed near the sample and detects gamma rays (photons) in coincidence with the alpha particles. Gamma rays (photons) produced in the sample by the n, γ reactions. The time difference between the alpha particle detection and gamma ray detection can provide position of the gamma ray source within the sample (i.e., location of the chemical substance within the sample). A three dimensional image is then provided by a scanning beam.

FNA allows for the concentrations of hydrogen, carbon, oxygen, and nitrogen to the detected and that the relative concentrations of these elements comprises a signature that further helps to identify a particular substance.

Note that the prior art further discloses the gamma ray (photon) detectors as being germanium detectors.

Additionally note that spectral analysis defining the chemical substances is also set forth in the prior art.

With regard to the claim language "adapted to" or "capable of" these clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ

705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

> A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647
>
> Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.
>
> Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1-4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawa et al (5,076,993) as applied to claims 5-12 and 14-17 above, and further in view of the admitted prior art (see specification: page 8, lines 6-7 and 21+; pages 15-16, lines 12-7; and page 17, lines, 1-7).

As set forth above Sawa discloses a prior art system capable of meeting applicant's claimed inventive concept; however, Sawa does not set forth the particulars of the analyzer as claimed. Nor does Sawa set forth the alpha detector as being a scintillation detector.

Applicant within the context of the disclosure (page 8, lines 6-7 and 21+; pages 15-16, lines 12-7; and page 17, lines, 1-7) sets forth that the analyzer, including the filtration and coincidence circuitry and well known in the art (i.e., conventional). Applicant further sets forth the use of a scintillation detector for detecting alpha particles as being well known in the art.

Clearly, modification of the prior art system of Sawa to have included the known analyzers and detection systems (scintillators), as admitted by applicant as being conventional, would have been obvious to one having ordinary skill in the art at the time the invention was made as such results are in no more than the use of conventionally known techniques/designs within the contraband detection system art.

Conclusion

12. The cited prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Keith whose telephone number is (703) 306-5752. The examiner can normally be reached on Monday through Friday from 7:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Jack Keith
Examiner,
Art Unit 3641

jwk

May 19, 2003